

AF



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of:

Clifford Kraft

Serial Number: 10/632,406

Filing Date: Aug. 1, 2003

Title: CELLULAR TELEPHONE
LOCATION SERVICE

) Art Unit: 2681

) Examiner: E. Gary

BRIEF ON APPEAL

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This appeal is taken from the final rejection of all claims pending in this application, claims 21-25 (See Appendix).

The notice of appeal to the Board of Patent Appeals and Interferences was timely filed by first class mail on Sept. 3, 2007. A final office action was issued June 5, 2007.

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APPEAL BRIEF

This is an appeal to the United States Patent Office Board of Patent Appeals and Interferences of application number 10/632,406 filed Aug. 1, 2003.

I. Real Party of Interest

The real party of interest is the inventor Clifford H. Kraft.

II. Related Appeals and Interferences

There are no other related appeals or interferences.

III. Status of the Claims

Claims 21-25 are on appeal.

There are no allowed claims. The status of each claim of the application is as follows:

Claim 1-20 (cancelled).

Claims 21-25 (rejected).

Claims 21-25 should be considered separately and do not stand or fall together.

IV. Status of Amendments

No amendments have been filed subsequent to the examiner's final rejection of June 28, 2006.

V. Summary of Claimed Subject Matter

A) General

The present invention provides a way of requesting the location of a person with a cellular telephone from either a telephone service provider or a location service agency. The cellular telephone can be located by GPS, assisted GPS or by any other means. The provider or agency providing the location service can return the location in a human understandable form such as a voice or written description that the cellular telephone is located at a particular intersection or in a particular building. The cellular user can lock out location reporting by taking some action on the cellular telephone such as by entering a particular sequence of letters or numbers on the telephone keypad or by entering a code of some type. Location blocking can last for a duration determined by the cellular user. The present invention is particularly useful for parents who might be worried about the location of a teenager. Permission to locate may be given to a particular person (parent) or group of people but denied to all others.

Figure 1 is a block diagram of the system of the present invention. The position of a handset telephone (1) is determined by GPS or by other any other location method. A consumer can contact a location facility (2) through either landline telephone, the internet or another cellular telephone and request the facility (2) to locate the handset. Telephone and internet inquiries can flow through a central telephone office (4). Emergency 911 (3) can also request the location of the handset. If the owner of the handset has allowed location, the facility (2) can return the location to the consumer. The location can be given in straight longitude and latitude, or preferably in a spoken or visual form that allows the consumer to relate to the location ("corner of 1st street and Vine street", etc.).

In the case that the handset owner does not want to be located, he or she can "turn off" the location capability by taking an action on the handset such as pushing a button or entering a special code. This action or code can be relayed back to the location facility to notify it that the handset owner is refusing location requests from everyone (except Emergency 911) or from a particular set of people, or is allowing requests from only certain people (a teenager's parents only for example). The entry of a code can be similar to codes that are in current use for call transfer or call forwarding.

Figure 2 shows the flow of information between a consumer, a location service bureau and a telephone service provider in a particular embodiment of the present invention. The consumer sends a request (5) to the service bureau asking for the location of a particular cellular handset. Software or a person at the service bureau (6) forwards (7) the request to the correct service provider

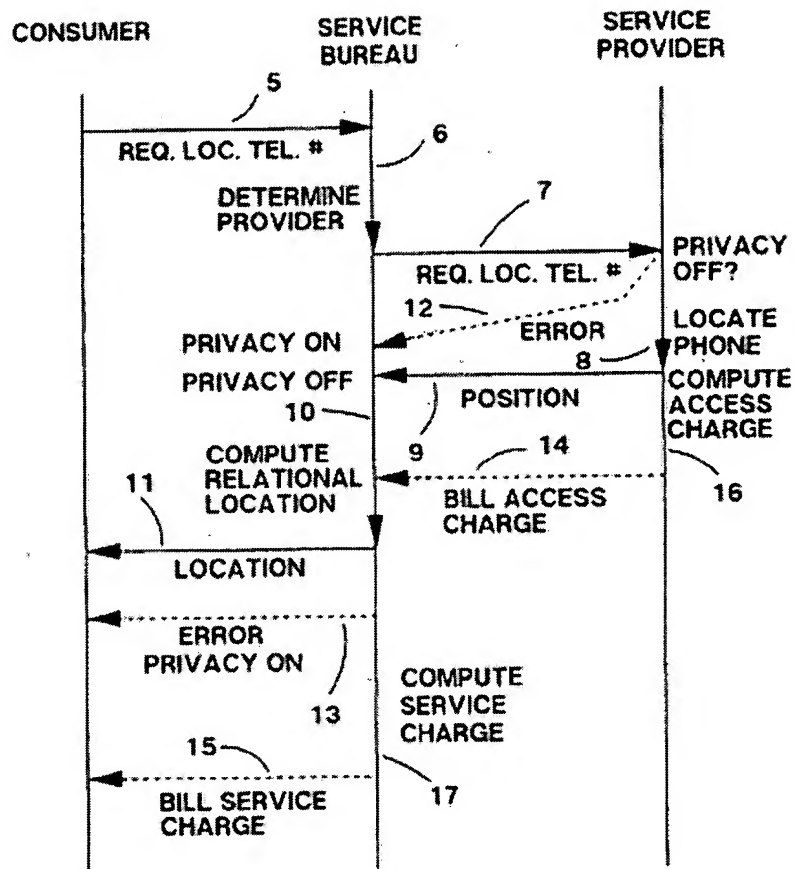


FIGURE 2

based on telephone number. If privacy is not turned on, the service provider locates the phone (8) and returns the location (9) to the facility who translates the location to a message in English or other language and returns the location (11) to the consumer. If privacy has been turned on by the telephone owner, a message (12) so stating can be returned to the facility and then to the consumer (13). The provider and facility can bill for the location service in some embodiments of the present invention.

B) Mapping of the Independent Claims to the Specification

The only independent claim is claim 21

Claim 21. A telephone location system (**Fig. 1, Abstract**) comprising:

a plurality of mobile telephone handsets (**Fig. 1, ref. 1**);

a telephone service provider providing telephone location services (**Fig. 1, refs. P and S**) in communication with said at least one of said mobile telephone handsets (**Fig. 1, ref. B to ref. 1**) wherein, said telephone service provider geographically locates said mobile telephone handset (**Abstract, p. 4, lines 6-18**), a handset owner being able to block location of said handset (**p. 5, lines 4-9**) for a time duration determined by said handset owner (**p. 5, lines 4-9; p. 6, lines 13-24; p. 7, lines 10-14**) by an action taken by said handset owner directly on said handset (**p. 5, lines 4-9**), said action causing said handset to send a message to said telephone service provider, wherein said telephone service provider blocks location determination (**p. 4, lines 8-9**);

said telephone service provider accepting a request from a consumer to locate a particular mobile telephone handset (**Fig. 1, ref. P**), said telephone service provider determining a geographic location of said particular mobile telephone handset (**Fig. 1, refs. GPS to 1 to B to S**)

when said user allows such determination (**p. 5, lines 4-9**); said telephone service provider than communicating said mobile telephone handset location to said consumer (**Fig. 3, ref. 8**);

wherein said mobile telephone handset location is returned to said consumer in relational form by written description (**p. 11, lines 2-6**) and shown on a map (**Fig. 2, P. 4, line 17**); and

wherein a particular consumer, by sending a predetermined message to said telephone service provider, can cause said telephone service provider to locate said mobile telephone handset even when said handset owner has blocked location of said mobile telephone handset (**p. 7, lines 9-15**).

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 21-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Herle et al (U.S. Publication No. 2003/0035544) in view of Ross (U.S. Publication No. 2003/0236095) in further view of Wilson et al. (U.S. Publication No. 2004/0203903).

VII. Argument

A. History of the Prosecution

A provisional application was filed April 10, 2003. The present utility application was filed Aug. 1, 2003. A first office action was received on May 3, 2005, and a response was filed on Aug. 2, 2005. A final office action was received on Sept. 26, 2005. A phone conference was held with the examiner on Dec. 29, 2005. A request for continued examination with a petition for a one month delay was filed on Jan. 25, 2006. A non-final office action was received on Feb. 10, 2006, and a response was filed on April 28, 2006. A final office action was received on June 28, 2006. A notice of appeal was filed on Sept. 22, 2006. The appeal was withdrawn and an RCE was filed Nov. 28, 2006. A non-final office action was issued Dec. 19, 2006. A final office action office action was issued June 5, 2007, and a notice of appeal was filed Sept. 3, 2007 followed by this brief.

B. Issue:

Whether claims 21-25 are rendered obvious by the Herle et al. reference in view of the Ross reference and in further view of the Wilson reference.

C.. Introduction

1. Description of the Herle et al. Reference ("Herle")

Herle et al. (U.S. Pub. 2003/0035544) teaches a mobile location server generally operated by a telephone service provider that can determine a mobile station's location using a variety of techniques. A requesting client transmits a request to the server over the Internet. If the client is authorized, the server

transmits location information in either encrypted or plain-text form to the client (abstract and [0007]-[0008]). Herle teaches a service provider selling location information on a pay-per-use basis [0052] and the use by parents to locate and keep track of children [0053]. Herle does not teach reporting location information in relational form using a map, and it does not teach a mobile user being able to prevent location information from being reported by an action on the mobile telephone where the blocking takes place during a time duration determined by the user, in fact, it does not teach blocking location information at all.

2. Description of the Ross Reference ("Ross")

The Ross reference (US Pub. 2003/0236095) teaches an information broker that operates a location server coupled to a wireless network (abstract). This server acquires and processes the location of mobile telephones on a network. The location of a particular mobile telephone may be provided by the broker to a recipient in exchange for a payment. The data returned may include maps of geographic areas where mobile users have been located (abstract, [0004]).

Ross is directed to providing location information of mobile users for determining movement trends behavioral patterns of mobile users and for providing location-based searches for customer analysis [0019] and [0024]. The location data is returned as raw longitude and latitude of mobile devices on the network [0028]. The raw longitude and latitude may be reduced to a more usable form [00289]. The more usable form taught by this reference is Map Data,

graphs of density, graphs of geographic locations, and time durations at particular locations [0019]. Ross does not teach returning locations as written English or other language references to streets, buildings or intersections or as voice descriptions.

Ross teaches gathering statistical data on a plurality of mobile phone users. It teaches away from locating a particular user.

Ross teaches the use of "privacy zones" that are determined by users in certain geographic regions. "In certain embodiments, 'privacy zones' may be specified by mobile device users [0051]. A privacy zone is a geographic area such that the mobile device user does not want his location data to be gathered and/or disclosed when he is in that area. Privacy zones may be defined within the location server 1 in response to inputs from mobile device users." [0051]. Ross teaches privacy only in particular geographic regions or zones; it does not teach privacy in any geographic region for a particular time duration determined by the mobile telephone user or an action by the user on his handset that prevents location determination.

3. Description of the Wilson et al. Reference ("Wilson")

Wilson et al. (U.S. Pub. 2004/0203903) teaches a system for providing wireless telecommunications services to mobile devices by managing permissions with a method of receiving a stop request with respect to one mobile device to stop other mobile devices from receiving location information with respect to it (abstract). The method updates a central database based on the

received stop request and prohibits other mobile devices from receiving location information with respect to the mobile related to the stop request until the stop request is removed (abstract).

Wilson teaches to a system and associated method that allows users to locate friends or other contacts. A user of a wireless device may identify the locations of selected individuals (via their wireless devices) [0037].

Wilson teaches the ability to quickly locate a friend [0038]. The system receives a request from a first mobile device to locate a second mobile device. [0039]. A user can add or remove himself from a particular list of friends and can refuse to allow a certain other user to locate him [0038]. Wilson does not teach a service that locates a particular mobile telephone for a user at a fixed location, or a service that locates a mobile telephone for a fee. In particular, Wilson does not teach translation of locations to streets, intersections and buildings where the mobile is located other than the simple translation of longitude and latitude to a street address. There is no teaching of maps. Buildings are located only for the purpose of providing directions to them. Wilson teaches away from simply locating a mobile telephone based on telephone number since it requires the numbers of both the locator friend and the located friend to exchange telephone numbers [0095].

Wilson states that a friend can “go invisible” and deny another access to his location [0135]; [0157]; however, this is done when someone requests his location on a case by case basis [0138] or with a “deny always list” for a particular friend [0138] or group of friends [0151]. A user may become “invisible”

so that the system does not provide the user's location to any friend [0157].

Wilson teaches "invisibility" during certain time periods, in certain geographical locations, and to certain or all others [0158] – [0162].

Wilson teaches a dedicated button or switch on the mobile device to permit the user to turn "invisibility" off and on [0167]; however, there is no teaching of entering a code on the mobile, or of the mobile sending a message to a location service that location is not to be reported. There is also no teaching of sending a message to a telephone provider to locate the mobile telephone even when its owner has blocked location determination.

D. The Legal Standard for Obviousness

The PTO has the burden under 35 U.S.C. Sec. 103(a) to establish a *prima facie* case of obviousness. In re Thrift, 298 F.3d 1357, 1363, 63 U.S.P.Q.2d 2002, 2006 (Fed. Cir. 2002). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. In re Brouwer, 77 F.3d 422, 425, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1996) ("when the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned").

Recently, in order to determine when two or more references may be combined, in KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007), the U.S. Supreme Court, while rejecting a rigid application of the teaching, suggestion, or motivation test, nevertheless held that "some articulated reasoning with some

rational underpinning” was required to combine two or more references. Id. at 1741. In addition, the U.S. Supreme Court cautioned that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

If an independent claim is found to be non-obvious under 35 U.S.C. Sec. 103, then any claim depending therefrom is also non-obvious. In re Fine, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

E. Claims 21-25 are not rendered obvious by the Herle et al. reference ("Herle") in view of the3 Ross reference ("Ross") in view of the Wilson reference ("Wilson").

The applicant agrees with the examiner that the cited references teach a telephone service provider in communication with at least one mobile telephone wherein the service geographically locates the mobile telephone handset. The applicant also agrees with the examiner that the references teach returning street addresses and map locations.

1. The cited references do not teach a handset owner being able to block location of the handset for a time duration determined by the handset owner by an action taken directly on the handset where the action sends a message to the telephone provider and the provider blocks the location.

Wilson teaches a button on the handset that can cause a handset to become invisible [0067]; however, Wilson teaches that this is a local action that sets an invisibility flag on the handset. There is no teaching of sending a message to the provider in response to the use of this button, not is there any teaching of the provider blocking location reporting based on this action. While Wilson teaches a "locate flag" [0156] being set, and teaches that this flag should be located in the handset, namely in removable memory 4114 or non-removable memory 4112 [0165]. There is no teaching whatsoever about sending a message when the button is pushed or the flag is set.

2. The cited references do not teach sending a predetermined message to the telephone service provider that causes the provider to locate the handset even when the handset owner has blocked location determination.

Wilson teaches: "A locate flag associated with Friend 1 is set to always be on so that Friend 1 may always locate the user, even if the user turns the locate feature off ("goes invisible"). For example, Friend 1 may be the user's spouse, and the user always wishes his or her spouse to locate him or her." [0156]. This teaches away from sending a predetermined message to the telephone service provider that causes the telephone service provider to locate the handset in spite of the fact that location has been blocked by the user.

The difference between this and the applicant's invention is that the phone user allows the spouse to override "invisibility" by setting a flag for that spouse as a "friend". The user can revoke this flag at any time, thereby preventing the

spouse from overriding the blocking. In the applicant's invention, the user cannot revoke the override privilege without contacting the provider. If the correct message is sent by the spouse to the service provider, the override occurs, and the user's location is reported. This feature of the applicant's invention is useful with teenagers who might decide to revoke the override privilege to avoid being located by their parents. If the parent can send the correct predetermined message, the teenager can be located regardless. While the general privilege may be changed in the applicant's invention, it cannot be changed on the fly by the handset user (for example, the teenager).

3. The examiner has failed to make a *prima facie* case of obviousness.

Since the references cited by the examiner do not contain or teach all of the limitations of the claims in a manner that would allow a person of ordinary skill in the art to practice the invention, the cited references, alone or combined, cannot render the applicant's claimed invention obvious. The examiner has failed to provide the requirements of a *prima facie* case of obviousness as required by 35 U.S.C. §103(a) as explained in In re Thrift. By rejecting for obviousness without finding all of the elements present in the references, the examiner is making a conclusory statement forbidden by KSR Int'l Co.

4. The Ross and Wilson references teach away from each other.

Ross teaches a geographic "privacy zone" [0051] that is location-related, not time or handset related. Wilson teaches "invisibility" [0135] that is controlled

by a user set flag. This is handset-related and teaches away from a location-related privacy system. Both references teach away from the applicant's invention that is time duration related, and is set by the user only by sending a message to the server, and that can be overridden by sending a predetermined message to the telephone service provider.

VIII. Conclusion

The Appellant respectfully submits that the that no combination of the Herle et al., Ross or Wilson et al. references renders the claimed invention obvious.

Respectfully submitted



Clifford H. Kraft (Reg. No. 35,229)
Attorney of Record



APPENDIX I. Claims on appeal

Claim 21. A telephone location system comprising:

a plurality of mobile telephone handsets;

a telephone service provider providing telephone location services in communication with said at least one of said mobile telephone handsets wherein, said telephone service provider geographically locates said mobile telephone handset, a handset owner being able to block location of said handset for a time duration determined by said handset owner by an action taken by said handset owner directly on said handset, said action causing said handset to send a message to said telephone service provider, wherein said telephone service provider blocks location determination;

said telephone service provider accepting a request from a consumer to locate a particular mobile telephone handset, said telephone service provider determining a geographic location of said particular mobile telephone handset when said user allows such determination; said telephone service provider then communicating said mobile telephone handset location to said consumer;

wherein said mobile telephone handset location is returned to said consumer in relational form by written description and shown on a map; and

wherein a particular consumer, by sending a predetermined message to said telephone service provider, can cause said telephone service provider to locate said mobile telephone handset even when said handset owner has blocked location of said mobile telephone handset.

Claim 22. The telephone location system of claim 21 wherein said telephone service provider also returns a longitude and latitude representing the location of said mobile telephone handset to said consumer.

Claim 23. The telephone location system of claim 21 wherein said telephone service provider also returns a voice description of the location of said mobile telephone handset to said consumer.

Claim 24. The telephone location system of claim 21 wherein said predetermined message is a PIN.

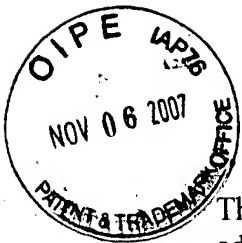
Claim 25. The telephone location system of claim 21 wherein said predetermined message is a password.

APPENDIX II. Evidence Appendix

NONE

Appendix III. Related Proceedings Appendix

NONE



This paper is being submitted by United States First Class Mail with sufficient postage addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450 on:

Date: Nov. 3, 2007

Signature: Clifford Kraft

Name: **Clifford H. Kraft**